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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,780	08/29/2003	Rhonda Sue Johnson	00775-0148US	3427

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WOOD, PHILLIPS, KATZ, CLARK & MORTIMER  
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SUITE 3800  
CHICAGO, IL 60661

EXAMINER

PICKETT, JOHN G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/652,780

Applicant(s)

JOHNSON, RHONDA SUE

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/24/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action acknowledges the applicant's Amendment submitted 24 January 2005. Claims 1-24 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The examiner inadvertently omitted the direct reference to claim 23 in the previous Office Action. However the subject matter of the claim was addressed in section 2 of the action.

### ***Claim Rejections - 35 USC § 103***

4. The applicant has established common ownership (or obligation of assignment) between the instant application and McDonald (US 2004/0074936 A1). As such, according to 35 USC 103(c), the rejection of claims 1-24 based upon McDonald are hereby withdrawn.
5. Claims 1-7, 9-19, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler (US 2003/0080133 A1; previously supplied to applicant) in view of Weimer (US 2003/0168371 A1; previously supplied to applicant).

Regarding claims 1, 4, 9-11, 13, and 21, Butler discloses an insulated (paragraph [0015]) soft-sided lunch cooler/kit **8** with a pliable body **10**. As body **10** of Butler forms a

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cavity **12**, sides, bottom, and loading/unloading access opening are deemed inherent. Butler further discloses a pliable top panel **14** hinged to the body (see paragraph [0016]), sized to close the access opening (see Figure 1) and a quick access structure including a quick access opening **17** and flap **16**.

Butler merely lacks the decorative figure.

Weimer teaches incorporating the structures of the cooler/kit into a decorative figure (see for example, Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the cooler/kit of Butler with a decorative figure in order to provide the consumer with a theme to promote sales. A change in aesthetic (ornamental) design generally will not support patentability. *In re Seid*, 73 USPQ 431.

As to claims 2, 19 and 22, the portions of the cooler/kit structure incorporated into the decorative figure are deemed an obvious matter of design choice. A change in aesthetic (ornamental) design generally will not support patentability. *In re Seid*, 73 USPQ 431.

As to claims 3, 15, and 23, Butler discloses tab **22**. The portions of the cooler/kit structure incorporated into the decorative figure are deemed an obvious matter of design choice. A change in aesthetic (ornamental) design generally will not support patentability. *In re Seid*, 73 USPQ 431.

As to claims 5 and 16, Butler discloses a zipper (see paragraph [00016]).

As to claims 6, 7, 17, and 18, Butler discloses tab **22**. Weimer discloses a car figure, however, the selection of any figure would have been an obvious matter of

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design choice. A change in aesthetic (ornamental) design generally will not support patentability. *In re Seid*, 73 USPQ 431.

As to claims 12 and 14, Butler does not expressly disclose the material of flap **16**. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form flap **16** from the same material as lid **14** in order to maintain the insulating properties of the cooler/kit. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

6. Claims 1, 2, 4-6, 8-11, 13, 16, 17, 19-22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Workman (US 4,537,313) in view of Hodosh et al (US 6,116,045) and Weimer (US 2003/0168371 A1).

Regarding claims 1, 4, 9-11, 13, and 21, Workman discloses an insulated soft-sided lunch kit (Figures 1 & 2) with a pliable body **10, 12, 14 & 18** having sides **10, 12, 14 & 18**, bottom, and loading/unloading access opening (see Col. 1, lines 61-66, and Figures 1 and 2). Workman lacks a quick access structure and decorative figure

Hodosh et al discloses a quick access structure (Figures 4a and 4b) having an access opening 156 & 158 and flaps 190. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the cooler/kit of Workman with a quick access structure as taught by Hodosh et al in order to seat a bottle or can within the lid.

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As to the decorative figure, Weimer teaches incorporating the structures of the cooler/kit into a decorative figure (see for example, Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the cooler/kit of Workman-Hodosh with a decorative figure in order to provide the consumer with a theme to promote sales. A change in aesthetic (ornamental) design generally will not support patentability. *In re Seid*, 73 USPQ 431.

As to claims 2, 19 and 22, the portions of the cooler/kit structure incorporated into the decorative figure are deemed an obvious matter of design choice. A change in aesthetic (ornamental) design generally will not support patentability. *In re Seid*, 73 USPQ 431.

As to claims 5 and 16, Workman discloses a zipper **30**.

As to claims 6 and 17, Weimer discloses a car figure, however, the selection of any figure would have been an obvious matter of design choice. A change in aesthetic (ornamental) design generally will not support patentability. *In re Seid*, 73 USPQ 431.

As to claims 8, 20, and 24, Hodosh et al discloses storage compartments **152 & 154**.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection. However, the examiner will address certain arguments presented by the applicant insofar as they may apply to the above rejections.

8. In response to applicant's argument that the rigid lid of Weimer is inappropriate for a soft-sided cooler, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). As to the incorporation of the flap and/or tab into the design, a change in aesthetic (ornamental) design generally will not support patentability. *In re Seid*, 73 USPQ 431.

### ***Conclusion***

9. As the examiner has introduced new grounds of rejection, this Office Action is made **NON-FINAL**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Greg Pickett  
Examiner  
5 April 2005



Mickey Yu  
Supervisory Patent Examiner  
Group 3700